

HP Docket No. 10003333-1

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. In order to place the application in condition for allowance, or alternately in better condition for appeal, claims 1, 4, 7, 9, 12-13, 18, 20, and 33 have been amended, and claims 2-3, 5-6, 14, 19, and 34-36 have been cancelled without prejudice. Independent claim 1 has been amended to include the essential limitations of prior claims 2 and 3. Independent claims 13 and 18 have been amended in a similar manner as claim 1. The other claims have been amended to correct dependency and provide consistent terminology. Applicants believe that these amendments to the abovementioned claims do not present new matter, and therefore request entry of this amendment. Therefore, reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Statement of Substance of Examiner Interview

Applicants' attorney thanks Examiner for the telephone interview on 05/20/2004. The following statement is provided in accordance with MPEP 713.04:

- (A) No exhibit was shown nor demonstration conducted.
- (B) Claims 1-3 were discussed.
- (C) The Tello reference (US 6,381,634) and the Agraharam reference (US 5,987,508)) were discussed.
- (D) No substantive amendments were proposed.
- (E) Applicants' attorney stated that the references were directed to the aliasing of one e-mail address to another, rather than to Applicant's invention of the configuring of a computer or device to communicate with its ISP. Applicants' attorney further argued that claims 1 and 2 recited a "mail server" and a "mail server name" not taught by the references, and that claim 3 recited limitations regarding the

HP Docket No. 10003333-1

construction of mail server names from e-mail addresses and mail server prefixes that were not taught by the references. After considering Applicants' position, Examiner stated that he still believed that the references anticipated the limitations of claims 1 and 2.

(F) No other pertinent matters were discussed.

(G) No agreement was reached as to claims 1-2. With regard to claim 3, the Examiner agreed that the claimed limitations in combination with the limitations of claim 1-2 were not taught by the cited references. The Examiner stated that he would enter an amendment that combined claims 1-3, and would conduct a further search.

(H) The interview was not conducted by electronic mail.

Rejections

Rejection Under 35USC Section 102(e)

Claims 1, 9-11, 13, 15, 18, 20-21, and 33 have been rejected under 35 USC Section 102(e), as being anticipated by U.S. patent 6,381,634 to Tello et al. ("Tello"). Applicants respectfully traverse the rejection and request reconsideration based on the amendments to claims 1, 9, 13, 18, 20, and 33, and features in the other claims which are neither disclosed nor suggested in the cited reference.

The rejection of independent claim 1, and its dependent claims 9-11, is respectfully traversed for at least the following reasons. As amended, claim 1 recites:

1. A method of communicating with a mail server associated with an on-line provider, comprising:

providing an e-mail address for the on-line provider, the e-mail address including a suffix indicative of a domain identifier;

converting the e-mail address to a machine-selected mail server name by prepending a selected one of a predetermined set of mail server prefixes to the suffix to form the machine-selected mail server name;

HP Docket No. 10003333-1

linking to a mail port of a computer having the machine-selected mail server name so as to determine whether the machine-selected mail server name corresponds to the mail server; and

communicating with the mail server when the machine-selected mail server name corresponds to the mail server.

In contrast, the Tello reference fails to anticipate the essential elements of “converting the e-mail address to a machine-selected mail server name by prepending a selected one of a predetermined set of mail server prefixes to the suffix” of the e-mail address, and “linking to a mail port of a computer having the machine-selected mail server name so as to determine whether the machine-selected mail server name corresponds to the mail server”. Such elements can be found only in Applicants’ disclosure, and to read them into the Tello reference constitutes impermissible hindsight. The Tello reference is directed to a completely different problem than is Applicants’ invention. Tello teaches translating a portable (“well-known”) e-mail address (e.g. name@@well.known) into a corresponding literal e-mail address associated with a user’s ISP (e.g. userx@commercial_isp.com), thus providing e-mail portability if the user changes his ISP (Abstract; col. 3, lines 48-65). In Tello, the e-mail application (Fig. 3) run by the User on his computer knows how to communicate with ISP 100 over communications link “a” (Fig. 1), but it doesn’t know the literal e-mail address of the recipient. Conversely, Applicants’ claimed invention may be beneficially utilized in an environment in which a computer does not know how to communicate with its ISP’s mail server. Accordingly, anticipating all the elements of Applicants’ claim 1 in Tello could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper for at least these reasons and should be withdrawn.

Although the Examiner has rejected these claims under 35 USC Section 102(e), Applicants note that these claims are also not rendered obvious under 35 USC Section 103(a) over Tello in view of U.S. patent 5,987,508 to Agraharam et al. (“Agraharam”). At col. 3, lines 24-50, Agraharam teaches e-mail address translation between an alias telephone number e-mail address (e.g. 2015558765@email.att.net) and an actual e-mail address (e.g. steveg@aftmail.com). For similar reasons as explained above, Tello in view of Agraharam fails to teach or suggest the claimed limitations of “converting the e-mail address to a

HP Docket No. 10003333-1

machine-selected mail server name by prepending a selected one of a predetermined set of mail server prefixes to the suffix" of the e-mail address, and "linking to a mail port of a computer having the machine-selected mail server name so as to determine whether the machine-selected mail server name corresponds to the mail server".

The rejection of independent claim 13, and its dependent claims 15 and 33, is respectfully traversed for at least the following reasons. As amended, claim 13 recites:

"13. A system for e-mailing information to a recipient over the Internet, comprising:
an electronic device adapted for periodic connection to an Internet service provider and to a configuration computer, the electronic device having
a parameter memory,
a storage subsystem coupled to the parameter memory and responsive to a command from the configuration computer for storing configuration parameters in the parameter memory, the configuration parameters including a mail server name associated with the Internet service provider, and
an e-mail subsystem coupled to the parameter memory and responsive to a user request to connect to an e-mail server of the Internet service provider using the mail server name and to e-mail the information to the recipient; and
a configuration program executable by the configuration computer to determine the mail server name, the configuration program including a parser to isolate a suffix indicative of a domain identifier from an e-mail address associated with the e-mail server, and a concatenator to prepend one of a predefined set of mail server prefixes to the suffix to form the mail server name."

In contrast, the Tello reference fails to anticipate the essential elements of "a configuration program ... to determine the mail server name ... including a parser to isolate a suffix indicative of a domain identifier from an e-mail address associated with the e-mail server, and a concatenator to prepend one of a predefined set of mail server prefixes to the suffix to form the mail server name". For similar reasons as explained above with reference to claim 1, such elements can be found only in Applicants' disclosure, and to read them into the Tello reference constitutes impermissible hindsight.

Although the Examiner has rejected these claims under 35 USC Section 102(e), Applicants note that these claims are also not rendered obvious under 35 USC Section 103(a) over Tello in view of U.S. patent 5,987,508 to Agraharam et al. ("Agraharam"). For similar reasons as explained above with reference to claim 1, Tello in view of Agraharam fails to

HP Docket No. 10003333-1

teach or suggest the configuration program as claimed by Applicants.

The rejection of independent claim 18, and its dependent claims 20-21, is respectfully traversed for at least the following reasons. As amended, claim 18 recites:

“18. A program storage medium readable by a computing apparatus, tangibly embodying a program of instructions executable by the computing apparatus for configuring an electronic device to send e-mail via a mail server of an on-line access provider, the program storage medium comprising:

a first segment of the instructions configured to convert an e-mail address for a user of the on-line access provider to a mail server name by prepending a selected one of a predetermined set of mail server prefixes to a suffix portion of the e-mail address to form the mail server name;

a second segment of the instructions configured to connect to the mail server using the mail server name so as to verify validity of the mail server name; and

a third segment of the instructions configured to download the mail server name to the electronic device.”

In contrast, the Tello reference fails to anticipate the essential elements of “a first segment of the instructions configured to convert an e-mail address for a user of the on-line access provider to a mail server name by prepending a selected one of a predetermined set of mail server prefixes to a suffix portion of the e-mail address to form the mail server name”, and “a second segment of the instructions configured to connect to the mail server using the mail server name so as to verify validity of the mail server name”. For similar reasons as described above with reference to claim 1, such elements can be found only in Applicants’ disclosure, and to read them into the Tello reference constitutes impermissible hindsight.

Although the Examiner has rejected these claims under 35 USC Section 102(e), Applicants note that these claims are also not rendered obvious under 35 USC Section 103(a) over Tello in view of U.S. patent 5,987,508 to Agraharam et al. (“Agraharam”). For similar reasons as explained above with reference to claim 1, Tello in view of Agraharam fails to teach or suggest at least the first and second segments of the instructions as claimed by Applicants.

Rejection Under 35USC Section 103

Claims 4, 7-8, and 12 have been rejected under 35 USC Section 103 (a), as being

HP Docket No. 10003333-1

unpatentable over U.S. patent 6,381,634 to Tello et al. ("Tello") in view of U.S. patent 5,987,508 to Agraharam et al. ("Agraharam"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claim 4, 7, and 12, and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

The rejection of dependent claim 4, and its dependent claim 8, is respectfully traversed for at least the following reasons. As amended, claim 4 recites:

"4. The method of claim 1,
wherein the e-mail address includes a first prefix portion and a first separator portion,
and
wherein the converting includes
stripping the first prefix portion and the first separator portion from the e-mail
address, and
appending a second separator different from the first separator to the selected one of a
predetermined set of mail server prefixes so as to form the mail server name associated with
the on-line provider."

Dependent claims 4 and 8 are allowable based on the allowability of base claim 1, as has been discussed heretofore. Additionally, neither the Tello nor Agraharam references teach or suggest appending a second separator different from a first separator to the selected one of a predetermined set of mail server prefixes to form the mail server name. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper and should be withdrawn.

The rejection of dependent claim 7 is respectfully traversed for at least the following reasons. As amended, claim 7 recites:

"7. The method of claim 1, further including:
if validity of the mail server name is not verified, repeating the prepending and linking using a different one of the predetermined set of mail server prefixes."

Dependent claim 7 is allowable based on the allowability of base claim 1, as has been

HP Docket No. 10003333-1

discussed heretofore. Additionally, neither the Tello nor Agraharam references teach or suggest repeating the prepending and linking with a different prefix. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper and should be withdrawn.

The rejection of dependent claim 12 is respectfully traversed for at least the following reasons. As amended, claim 12 recites:

"12. The method of claim 1, wherein the suffix includes at least two domain levels and a separator between each of the at least two domain levels, and wherein the converting further includes stripping a left-most domain level and a left-most separator from the suffix prior to the prepending if the suffix includes more than two domain levels."

Dependent claim 12 is allowable based on the allowability of base claim 1, as has been discussed heretofore. Additionally, neither the Tello nor Agraharam references teach or suggest stripping a left-most domain level and separator from the suffix prior to the prepending if the suffix includes more than two domain levels. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper and should be withdrawn.

Claims 16-17 and 32 have been rejected under 35 USC Section 103 (a), as being unpatentable over U.S. patent 6,381,634 to Tello et al. ("Tello") in view of U.S. patent 6,525,768 to Obradovich. Applicants respectfully traverse the rejection and believe that dependent claims are allowable at least based on the allowability of base claim 13, as has been discussed heretofore.

Claims 30-31 have been rejected under 35 USC Section 103 (a), as being

HP Docket No. 10003333-1

unpatentable over U.S. patent 6,381,634 to Tello et al. ("Tello") in view of U.S. patent 6,574,670 to Eguchi. Applicants respectfully traverse the rejection and believe that dependent claims are allowable at least based on the allowability of base claim 13, as has been discussed heretofore.

Conclusion

Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.